REMARKS

New claims 30-32, which depend respectively from independent claims 1, 12 and 22, have been added. Support for the new claims may be found, for example, at page 6, lines 22-23 of the pending specification.

Claims 1, 3-12, 14-22 and 24-32 are pending.

In the Office action, the claims were rejected as follows:

* Claims 1, 5-6, 12, 16-17 and 22 were rejected as anticipated by U.S. Patent No. 6,732,249 (Pickeign et al.).

* Claims 1, 5, 12, 16, 22 and 26 were rejected as anticipated by U.S. Patent No. 6,397,316 (Fesas).

* Claims 2, 6-8, 11, 13, 17-18, 23, 27 and 29 were rejected as unpatentable over the combination of the Fesas patent and U.S. Patent No. 6,260,124 (Crockett et al.).

* Claims 3-4, 14-15 and 24-25 were rejected as unpatentable over the combination of the Fesas patent and U.S. Patent No. 6,470,397 (Shah et al.).

* Claims 9-10, 19-20 and 28 were rejected as unpatentable over the combination of the Fesas, Crockett et al. and Shah et al. patents.

Claims 1, 12 and 22 have been amended by incorporating the limitations, respectively, from claims 2, 13 and 23 (now canceled). As explained in the pending specification in connection with one particular example:

> If the driver 50 gives control over to another application 52 that modifies 116 the contents of the EEPROM 15, the EEPROM buffer 35 is reinitialized 108 by copying the modified contents of the EEPROM into the buffer. If the contents of the EEPROM 15 are modified 118 by another application on the host memory 30 through the driver 50, the driver updates 120 the EEPROM buffer 35 when the driver modifies the EEPROM 15. The updates of the EEPROM buffer 35 can be conducted independent to any read requests.

In view of the amendments to claims 1, 12 and 22, the rejections of original independent claims 1, 12, 22 as anticipated by the Pickeign et al. and Fesas patents are moot.

The rejections of the pending claims (as amended) are based on a combination of the Fesas patent and at least one other reference under 35 U.S.C. § 103. The Fesas patent, however, is assigned to the same assignee (Intel Corporation) as the pending application. Furthermore, the Fesas patent has a publication date after the filing date of the pending application. Therefore, the Fesas patent is prior art (if at all) only under 35 U.S.C. § 102(e).

Pursuant to 35 U.S.C. § 103(c), the Fesas patent is not properly cited against the pending claims. That section states:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), an (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

At least for the foregoing reasons, applicant respectfully requests withdrawal of the rejections of the pending claims.

Furthermore, even if the Fesas patent were properly cited against the pending claims, one of ordinary skill in the art would not have been motivated to combine the disclosure of the Crockett et al. patent with that of the Fesas patent to obtain the subject matter of the pending claims.

First, in connection with claims 2, 13 and 23 (now incorporated, respectively, into claims 1, 12 and 22), the Office action states (at page 5, par. 22; *see also* page 6, par. 29) that "Fesas suggested exploration of art and/or provided a reason to modify the method with the synchronizing date feature (column 3 lines 31-36)." That is incorrect. The cited section of the

Fesas patent says nothing about exploring the art. Instead, that section of the Fesas patent, when properly read in context, discusses possible advantages of the subject matter of that patent. Moreover, the type of general disclosure mentioned by the Office action is hardly the type of "clear and particular" motivation that is required by the Court of Appeals for the Federal Circuit to combine references under 35 U.S.C. § 103. *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *Teleflex, Inc. v. Ficosa North Am. Corp.*, 63 USPQ2d 1374 at 1387 (Fed. Cir. 2002) (showing of motivation to combine references must be "clear and particular.").

Second, there would have been no motivation to combine either the Fesas patent (or the Pickreign et al. patent) with the Crockett et al. patent because they deal with different topics and significantly different problems. The Fesas patent relates to communications between a computer system and a network interface device (col. 1, lines 10-11). That patent addresses problems relating to bottlenecking that occurs as a result of translating virtual addresses to physical addresses (col. 2, lines 8-10 and lines 64-67) and problems relating to command blocks (col. 2, lines 33-35). Similarly, the Pickreign et al. patent addresses problems relating to bottlenecking that occurs when data is transferred from a network interface adapter (NIA) to a host computer (col. 1, lines 28-38).

In contrast, the Crockett et al. patent relates to the relationship between the contents of primary storage and backup storage in a digital data storage system (col. 1, lines 8-9; col. 2, lines 13-15). As explained by that patent:

> [T]he high cost of data loss warrants maintaining a duplicate copy of the data. Thus if the primary data is lost, corrupted, or otherwise unavailable, business can seamlessly continue by using the backup data instead of the primary data.

(Crockett et al., col. 1, lines 23-27) The Crockett et al. patent addresses how the data in backup storage can be synchronized with data in the primary storage. Those issues have nothing to do with what is addressed by either the Fesas patent or the Pickreign et al. patent, neither of which deal with backup storage.

In view of the foregoing remarks, it is clear that one of ordinary skill in the art would not have been motivated to combine the disclosures of wither the Fesas or Pickreign et al. patents with that of the Crockett et al. patent to obtain the subject matter of any of independent claims 1, 7, 12, 18, 22 and 27.

The Shah et al. patent does not add anything in that regard.

At least for those additional reasons, applicant respectfully requests withdrawal of the rejections of all the pending claims.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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Samuel Borodach
Reg. No. 38,388

Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099